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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,933	03/19/2001	Marc D. Better	11051US03 / 200-85	9646

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EXAMINER

MCKELVEY, TERRY ALAN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 06/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/811,933

Applicant(s)

BETTER, MARC D.

Examiner

Terry Mckelvey

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-- Th MAILING DATE f this communication appears on th cover sheet with the correspondence address --

## Peri d f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-51 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Pri rity under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, 9, 18-23, 26-31, 34-40, 43-48, and 51 only as they are drawn to use of a cell deficient in only the araE gene arabinose transporter system), drawn to method for producing a recombinant protein, classified in class 435, subclass 69.1.
- II. Claims 1-5, 7, 9, 18-22, 24, 26-30, 32, 34-39, 41, 43-47, 49, and 51 only as they are drawn to use of a cell deficient in only the araFGH gene arabinose transporter system), drawn to method for producing a recombinant protein, classified in class 435, subclass 69.1.
- III. Claims 1-5, 8-9, 18-22, 25-30, 33-39, 42-47, and 50-51 only as they are drawn to use of a cell deficient in both the araE and araFGH gene arabinose transporter systems), drawn to method for producing a recombinant protein, classified in class 435, subclass 69.1.

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- IV. Claims 10-15, only as drawn to bacterial host cell deficient in the araE gene arabinose transporter system, classified in class 435, subclass 252.1.
- V. Claims 10-14 and 16, only as drawn to bacterial host cell deficient in the araFGH gene arabinose transporter system, classified in class 435, subclass 252.1.
- VI. Claims 10-14, and 17, only as drawn to bacterial host cell deficient in both the araE and araFGH gene arabinose transporter system, classified in class 435, subclass 252.1.

Claims 1, 10, 18, 26, 34, and 43 link inventions drawn to the (use of) bacteria deficient in the araE gene arabinose transporter system, bacteria deficient in the araFGH gene arabinose transporter system and bacteria deficient in both arabinose transporter systems. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim. Upon the allowance of the linking claim, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise including all the limitations of the allowable linking claim will be entitled to examination in the instant application.

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Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because of the following reasons:

The method of producing recombinant protein of Groups I-III are chemically, biologically, and functionally distinct from each other and thus one does not render the other obvious. Each method uses a bacterial host cell that is chemically, biologically, and functionally distinct from the bacterial host cell used in the other groups because each host cell has a different type of impaired function in transporting arabinose, which does not make obvious the other types of impaired function. Therefore, the inventions of the three groups are capable of supporting separate patents.

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The bacterial host cells of Groups IV-VI are chemically, biologically, and functionally distinct from each other and thus one does not render the other obvious. Each bacterial host cell is chemically, biologically, and functionally distinct from the bacterial host cell in the other groups because each host cell has a different type of impaired functionality in transporting arabinose, which does not make obvious the other types of impaired functionality. Therefore, the inventions of the three groups are capable of supporting separate patents.

Inventions of Groups IV-VI and Groups I-III, respectively, are related as product and processes of use. (The other combinations of these two sets of groups are independent of each other because the products are not used in those methods.) The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process, replicating plasmids or any other function bacteria are used for.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by

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their different classification and the search required for Groups I-III and Groups IV-VI are not required for the other group members with regard to the non-patent literature because bacteria deficient in the particular arabinose transporter system(s) must be searched for separately (i.e., identifying art concerning bacteria deficient in one transporter system does not necessarily identify art concerning a defect in the other systems), restriction for examination purposes as indicated is proper.

A telephone call was made to Janet McNicholas on 4/26/02 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### **Conclusion**

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014.

NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning missing attachments or other minor formalities of this communication should be directed to the patent analyst, Zeta Adams, whose telephone number is (703) 305-3291.

Any inquiry concerning rejections or other major issues in this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (703) 305-7213. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 7:30 AM to about 6:00 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to his office).



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, can be reached at (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Terry A. McKelvey, Ph.D.  
Primary Examiner  
Art Unit 1636

June 22, 2002